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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAKOB NIELSEN

Appeal 2009-000207
Application 08/865,841
Technology Center 2100

Decided:[1] July 10, 2009

Before LEE E. BARRETT, LANCE LEONARD BARRY,
and JEAN R. HOMERE, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Patent Examiner rejected claims 1-26. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The invention at issue on appeal selectively adds terms used in search queries presented over a period of time to searchable data. More specifically, the terms are added as meta-tags to the data. (Spec. 3.)

ILLUSTRATIVE CLAIM

1. A web server for information retrieval, comprising:

a. a bus;

b. information storage accessible through the bus and containing stored information;

c. a network interface connected to the bus; and

d. a processor connected to said bus, said processor configured to receive non-predetermined search queries submitted by a client over said network interface, to process the search queries against the stored information, and to provide a list of terms used in the search queries presented over a period of time, wherein the list of terms are selectively added to the stored information against which the search queries are processed.

PRIOR ART

Brunner	US 5,550,971	Aug. 27, 1996
Cochran	US 5,995,979	Nov. 30, 1999

REJECTIONS

Claims 1-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Cochran.

Claims 19, 20, and 25 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Brunner and Cochran.

PREVIOUSLY USED SEARCH TERMS

Regarding claims 1-3, 7-13, 14-19, and 21-26 the Examiner finds that "Cochran discloses . . . the records identified by the search is used to form new lists of search terms (See Cochran Abstract, Col. 4, lines 1-57; Figure 2 and corresponding text). (Ans. 5.) The Appellant argues that "Cochran may create updated lists that were not originally searched." (App. Br. 11.)

ISSUE

Therefore, the issue before us is whether the Appellant has shown error in the Examiner's finding that Cochran generates a list of terms that have been used in search queries over a period of time.

LAW

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim . . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,* 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.,* 793 F.2d 1565, 1571 (Fed. Cir. 1986).

FINDINGS OF FACT ("FF(S)")

1. Cochran "enable[s] a user to view different lists of choices, or search terms, that are available in a unique search situation." (Col. 4, ll. 20-22.) More specifically, "[a] search of [a] database is conducted based upon selected search terms from at least one of . . . multiple lists. The subset of records identified by the search is used to form new lists of search terms that are then displayed on the display device." (Abstract.)

2. "The user may examine the new subset of search terms and either view one or all of the records located, further limit the search, or reset all or part of the search." (*Id.*)

ANALYSIS

Based on a user's initial selection of search terms from at least one of multiple qualifier lists, Cochran searches a database and identifies a subset of records corresponding to the selected search terms. The reference uses the subset of records to generate new lists of search terms. (FF 1.)

Cochran's user may employ the new lists of search terms to conduct a further search. (FF 2.) The search terms in the new lists, however, were not used in search queries over a period of time. In the Appellant's aforementioned words, we find that "Cochran . . . create[s] updated lists that were not originally searched." (App. Br. 11.)

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellant has shown error in the Examiner's finding that Cochran generates a list of terms that have been used in search queries over a period of time.

META-TAGS

Regarding claims 7-26, the Examiner makes the following findings.

> [Cochran's] Figure 4c is showing records for search result based on the default search terms 214-217 (see Col. 13, lines 4-13). In this case, the records are (metadata) that describes the search results (data). Also, according to the Applicant, "a meta-tag is an entry in a meta-information section of a document or file". Since entries can be made to list of search terms (meta information section), Cochran clearly discloses "meta tag".

(Ans. 14-15.) The Appellant argues that "[i]n Cochran, the search terms in this new list do not describe the document in which they are located, but merely 'correspond to at least one record in existence in the subset of records.' (col. 9, lines 5-6). Cochran therefore, fails to disclose 'meta-tag' . . . ." (App. Br. 14.)

ISSUE

Therefore, the issue before us is whether the Appellant has shown error in the Examiner's finding that Cochran adds at least one search term to a document or file as a meta-tag.

LAW

"Claims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc).

FINDINGS OF FACT

3. The Appellant includes the following description of a meta-tag. "Meta-information is information about information. Some documents or files contain sections which contain meta-information related to the contents of that document or file. An example of meta-information is a keyword list. A meta-tag is an entry in a meta-information section of a document or file." (Spec. 1.)

4. Figure 4c of Cochran shows "part of a record" (col. 13, l. 3) identified by a search of the reference's database.

ANALYSIS

A meta-tag is an entry in a meta-information section of a document or file. (FF 3.) The Figure of Cochran on which the Examiner relies shows part of a record identified by a search of the reference's database. (FF 4.) We disagree with the Examiner's premise that such "records are (metadata)

that describes the search results . . . ." (Answer 14.) To the contrary, such records constitute the search results. Rather than constituting an entry in a meta-information section of a document or file, moreover, the records constitute the document or file itself. The Examiner does not allege, let alone show, that the addition of Brunner cures the aforementioned deficiency of Cochran.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellant has shown error in the Examiner's finding that Cochran adds at least one search term to a document or file as a meta-tag.

CLAIMS 4-6

The issues before us are whether claims 4-6 are indefinite and whether the rejection of claims 4-6 is ripe for review.

LAW

"The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope." *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994) (citing *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 1217 (Fed. Cir.1991)). "[T]he definiteness of the language employed must be analyzed — not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

A rejection should not be based on "speculations and assumptions." *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). "All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious—the claim becomes indefinite." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

FINDING OF FACT

5. Independent claim 4 recites in pertinent part the following limitations: "at least one web server connected to said network, said server storing items in response to non-predetermined search queries received from the users, the server configured to provide a list of terms used in the search queries over a period of time, wherein the list of terms are selectively added to at least one of the stored items, the at least one of the stored items being selected by selections received from users using a browser."

ANALYSIS

Claim 4 specifies that at least one web server stores items in response to search queries received from users. (FF 5.) One of ordinary skill in the pertinent art, however, would not expect the web server to store data in response to the search queries. To the contrary, one would expect the web server to retrieve data in response to the search queries as is done in Cochran. (FF 1.) Furthermore, we are uncertain of the nature of the claimed "items." The claim itself distinguishes the items from the list of terms by specifying the adding of the list of terms to at least one of the stored items.

The aforementioned defects make claim 4 and claims 5 and 6, which depend therefrom, indefinite.

CONCLUSION

Based on the aforementioned facts and analysis, we reject claims 4-6 under 35 U.S.C. § 112, ¶ 2 as indefinite for failing to particularly point out and distinctly claim the Appellant's invention. For the reasons explained in addressing the indefiniteness of the claims, our analysis of these claims leaves us in a quandary as to what they specify. Speculations and assumptions would be required to decide the meaning of the terms employed therein and the scope of the claims. Therefore, we reverse *pro forma* the Examiner's rejection of these claims.

DECISION

We reverse the rejections of claims 1-26 and enter a new rejection against claims 4-6.

37 C.F.R. § 41.50(b) provides that "[a] new grounds of rejection pursuant to this paragraph shall not be considered final for judicial review." Section 41.50(b) also provides that, within two months from the date of the decision, the appellant must exercise one of the following options to avoid termination of proceedings of the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

> (2) *Request rehearing.* Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

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